



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,043	09/12/2000	Alain Benayoun	FR9-1999-0106 US1	6001

7590

04/13/2004

ANDREW DILLON
BRACEWELL AND PATTERSON LLP
111 CONGRESS AVENUE
SUITE 2300
AUSTIN, TX 78701

EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/660,043

Applicant(s)

BENAYOUN ET AL.

Examiner

Azizul Choudhury

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9-10 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Daigle (US Pat No: US005795297A), hereafter referred to as Daigle.

1. With regards to claim 1, Daigle teaches a system for downloading a data file from a web server to a user workstation through a network to which is connected said user workstation, having a hard disk for storing said data file being transferred over a SCSI bus (Daigle's design has a computer with disk drives for storing data with data being transferred over a SCSI bus (column 7, lines 11-15, Daigle)); said user workstation including a dual-port memory said dual-port memory for storing temporarily said data file having an input port and an output port (Daigle's design also has a computer with dual-port memory (column 10, lines 58-60, Daigle)) ; a network logic unit interconnected between said network and said input port for receiving said data file from said network and transmitting it to said dual-port memory (Daigle discloses the use of network cards which are equivalent to network logic units (column 3, lines 5-9, Daigle). Data received through the network cards inherently are sent to memory. Since Daigle's design uses

dual port memory, the network cards inherently send the data to dual port memory); and a SCSI logic unit inter connected between said output-port and said SCSI bus for transferring said data file from said dual-port memory to said hard disk over said SCSI bus (As stated before, Daigle's design implements the use of a SCSI bus to transfer data for storage. If data is transferred over a SCSI bus, the logic required to send it (such as the claimed SCSI logic unit) inherently must be present)).

2. With regards to claim 9, Daigle teaches a system comprising: a volatile system memory; a non-volatile memory; and a network adapter (The computers of Daigle's design have means for memory (front page figure). Daigle's system uses commercially available computers (column 2, lines 52-67, Daigle). It is then inherent that the computers of Daigle's design have both volatile and non-volatile memory means. In addition, Daigle further states that the computers have expansion slots by which to expand the computer with, such as network cards (column 6, lines 43-64, Daigle)), the network adapter including: a non-system memory capable of temporarily storing a packet received by the network adapter; and a microcontroller capable of evaluating the packet received by the network adapter; wherein if the microcontroller determines that the packet is destined for the system's non-volatile memory, then the microcontroller directly transfers the packet from the non-system memory in the network adapter to the system's non-volatile memory, and wherein if the microcontroller does not determine that the packet is destined for the system's non-volatiles memory, then the microcontroller transfers the packet from the non-system memory in the network

Art Unit: 2143

adapter to the volatile system memory (The network card of Daigle's design is an expansion card column 6, lines 52-67, Daigle). This means that the network card is contained within a card unit. If one looks into the expansion slots (such as PCI slots), they will notice that it is only an input/output interface. It is the card device itself (the network card in this case) that must have its own components by which to perform its designated tasks. In this case, a network card inherently must possess memory to hold data with, while it properly handles the data and at least one microcontroller with which to handle the data with. When data is to be received or transmitted by a network card, the data must be held within the card, hence memory is needed within the network card. In addition, to properly send or receive the data (that includes delivering the data to the appropriate locations within the computer), a microcontroller must inherently be present to perform such tasks).

3. With regards to claim 10, Daigle teaches a system further comprising: a system bus connecting the network adapter to the volatile system memory; and a Small Computer System Interface (SCSI) bus connecting the network adapter to the system's non-volatile memory, wherein a transfer of the packet from the non-system memory in the network adapter to the system's non-volatile memory does not occur via the system bus (All computers including the ones of Daigle's design use buses with which to transfer data within the computer with (column 6, lines 43-64, Daigle). No limitation is provided regarding what type of bus is to be used, hence all reasonable types, including SCSI and system bus are considered acceptable within Daigle's design. In addition,

Art Unit: 2143

data transfer to the appropriate location inherently occurs through the appropriate bus.

This means the bus (such as a SCSI bus) designated to channel to the non-volatile memory from the network card will be used instead of other buses).

4. With regards to claim 12, Daigle teaches a system wherein the system's non-volatile memory is a hard disk in a hard disk drive that has a SCSI interface to the SCSI bus (The computer in Daigle's design is a typical computer and being such, it inherently has volatile memory and non-volatile memory. In addition, Daigle discloses that the computer in the example provided does have a hard drive (column 6, line 40, Daigle)).

5. With regards to claim 13, Daigle teaches a system wherein the microcontroller evaluates the packet by examining in the packet: an address source; an address destination; and a port number that indicates which transfer protocol is used by the packet, such that only packets having a pre-determined source and address destination and using a pre-determined port are transferred from the non-system memory in the network adapter to the system's non-volatile memory (As stated above, the network card of Daigle's design is an expansion card column 6, lines 52-67, Daigle). This means that the network card is contained within a card unit. If one looks into the expansion slots (such as PCI slots), they will notice that it is only an input/output interface. It is the card device itself (the network card in this case) that must have its own components by which to perform its designated tasks. In this case, a network card inherently must possess at least one microcontroller with which to handle the data with.

To properly send or receive the data (that includes delivering the data to the appropriate locations within the computer), a microcontroller must inherently be present to perform such tasks. In addition, to properly transport data in any data, the data packet must be examined for data specifying protocol specific information such as addresses and ports as claimed. It is based on such an examination that the network card is able to properly transmit and receive data for a computer).

6. With regards to claim 14, Daigle teaches a system wherein the microcontroller locally stores a listing of address sources, address destinations and port numbers that authorize the packet to be routed directly to the system's non-volatile memory (A microcontroller is a programmable device. It's performance and abilities are based upon the program created for and installed into the microcontroller. Abilities such as those claimed are programmable and hence the means are inherently present within the network card of Daigle's design).

7. With regards to claim 15, Daigle teaches a system wherein the packet is received from a network (Daigle's design discloses a computer with a network card (column 6, lines 43-64, Daigle). A network card receives and transmits data packets, such as those from networks as claimed).

8. With regards to claim 16, Daigle teaches a network adapter comprising: a non-system-memory capable of temporarily storing a packet received by the network

adapter; and a microcontroller capable of evaluating the packet received by the network adapter; wherein if the microcontroller determines that the packet is destined for a non-volatile memory in a system, then the microcontroller transfers the packet from the non-system memory in the network adapter to the non-volatile memory, and wherein if the microcontroller does not determine that the packet is destined for the non-volatile memory, then the microcontroller transfers the packet from the non-system memory in the network adapter to a volatile system memory (The network card of Daigle's design is an expansion card column 6, lines 52-67, Daigle). This means that the network card is contained within a card unit. If one looks into the expansion slots (such as PCI slots), they will notice that it is only an input/output interface. It is the card device itself (the network card in this case) that must have its own components by which to perform its designated tasks. In this case, a network card inherently must possess memory to hold data with, while it properly handles the data and at least one microcontroller with which to handle the data with. When data is to be received or transmitted by a network card, the data must be held within the card, hence memory is needed within the network card. In addition, to properly send or receive the data (that includes delivering the data to the appropriate locations within the computer), a microcontroller must inherently be present to perform such tasks).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2143

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daigle in view of Allen et al (US Pat No: 4570217), hereafter referred to as Allen.

9. With regards to claim 11, Daigle teaches through Allen, a system wherein the non-system memory in the network adapter is a dual-port memory, the dual-port memory having a first port coupled to the system bus and a second port coupled to the SCSI bus.

(Daigle teaches a design with network cards (column 3, lines 5-9, Daigle) and dual port memory (column 10, lines 58-60, Daigle). However, Daigle fails to specify that the memory within the network card is a dual port memory.

Allen teaches a design where a network card (local area network interface is equivalent to a network card) has dual port memory (column 320, lines 35-44, Allen). While Daigle's network card does have memory it did not specify the existence of dual port memory within the network card. Allen however teaches that the memory within network cards can be dual port memories. Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Daigle with those of Allen, for the purpose of creating a network card with dual port memory, to provide additional or enhanced capabilities for the PC which are directly compatible with the PC's architecture (column 6, lines 46-48, Daigle)).

Response to Arguments

The arguments filed by the applicant on January 30, 2004 have been thoroughly considered but they are not deemed fully persuasive. Brief explanations are provided below as a response to those arguments.

The independent claims do not disclose that the network card transfers data from a network directly to a computer's memory without using the computer's bus as stated within the specifications. Due to such omissions, the claims as written, failed to overcome Daigle's disclosure.

Applicant also argues that Daigle's design does not teach a network card with non-system memory and microcontroller. Examiner feels that Daigle's network card does possess such traits since it is a network card that is meant to fit into an expansion slot. The network card of Daigle's design is an expansion card column 6, lines 52-67, Daigle). This means that the network card is contained within a card unit. If one looks into the expansion slots (such as PCI slots), they will notice that it is only an input/output interface. It is the card device itself (the network card in this case) that must have its own components by which to perform its designated tasks. In this case, a network card inherently must possess memory to hold data with, while it properly handles the data and at least one microcontroller with which to handle the data with. When data is to be received or transmitted by a network card, the data must be held within the card, hence memory is needed within the network card. In addition, to properly send or receive the data (that includes delivering the data to the appropriate locations within the computer), a microcontroller must inherently be present to perform such tasks.

In addition, Allen teaches a design where network cards do contain dual port memory (column 320, lines 35-44, Allen).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

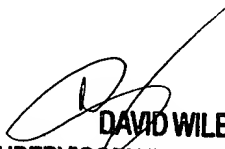
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is 703-305-7209. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100